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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,380	12/12/2003	Koki Okamura	FJ-2003-046-US	8530
21254 7590 11/14/2008 MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817				
EXAMINER				
PANNALA, SATHYANARAYA R				
ART UNIT		PAPER NUMBER		
2164				
MAIL DATE		DELIVERY MODE		
11/14/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/733,380

**Applicant(s)**

OKAMURA, KOKI

**Examiner**

Sathyanarayan Pannala

**Art Unit**

2164

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date attached.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's Amendment filed on 8/13/2008 has been entered with amended claims 1 and 4. In this Office Action, claims 1-15 are pending.

***Claim Objections***

2. Claim 5 is objected to because of the following informalities: the method claim has a series of instruction and did not specify how they are implemented. Applicant is suggested add "computer implemented method" in place of "method" and relate the implementation with hardware. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 4 are rejected under 35 U.S.C. 112, 2<sup>nd</sup> paragraph. Because claiming as in the preamble is "program recordable", as being indefinite in that it fails to point out what is included or excluded by the claim language. These claims are an

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omnibus type claims. It is not clear and ambiguous to claim indefinite phrase.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 10-14 are rejected under 35 U.S.C. § 101, because claims are directed to program per se. Independent claim 10 is claiming a computer program per se and functional descriptive material consisting of data structures and computer programs, which impart functionality when employed as a computer component. As such, the claims are not limited to statutory subject matter and are therefore non-statutory. As Claim 10 does not have any physical devices and relating them to the steps of the claim. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gohda (USPA Pub. 2002/0154226 A1) hereinafter Gohda, and in view of Pruett et al. (US Patent 5,778,389) hereinafter Pruett.

9. As per independent claim 1, Gohda teaches a system for processing of a representative picture of a moving image file (page 1, paragraph [0002]). Gohda does not explicitly teach selecting a file. However, Pruett teaches the claimed, when a file stored in a first folder is selected to be stored into a second folder, comparing a filename of the selected file with a filename of each file already stored in the second folder, as the computer world where files are stored in electronic file folders and either moved or copied between them (Fig. 2A, col. 6, lines 15, lines 28-30). Gohda does not explicitly teach checking whether the same name exists on the second folder. However, Pruett teaches the claimed, if the second folder contains no file having a filename same as the selected file, storing the selected file into the second folder (Fig. 2B, col. 6, lines 42-44). Pruett also teaches the claimed, if the second folder contains a file having a filename same as the selected file (Fig. 2B, col. 6, lines 49-52). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Pruett's

teachings would have allowed Gohda's method to provide an automatic synchronization of directories in order to eliminate inefficient and time-consuming method by using standard operating system commands (col. 1, lines 56-58). Finally, Gohda teaches the claimed, to display thumbnail images and file information of the selected file and the file having the same filename together on a display device and asking a user whether to (Fig. 6, page 5, paragraph [0094]).

Gohda and Pruett do not explicitly teach asking a user whether to overwrite a file. However, Nelson teaches the claimed, asking a user whether to overwrite the file (Fig. 2, col. 7, lines 46-52). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Nelson's teachings would have allowed Gohda's method to provide a user previous version if a change need to be reversed (col. 1, lines 56-58).

10. As per dependent claim 2, Gohda teaches the claimed, if at least one of the selected file and the file having the same filename comprises a movie file, displaying a first frame of the movie as the thumbnail image thereof on the display device, and to playing back the movie upon operation to the thumbnail image (Fig. 2, page 3, paragraph [0053]).

11. As per dependent claim 3, Gohda teaches the claimed, if at least one of the selected file and the file having the same filename comprises an audio file, displaying an icon image as the thumbnail image thereof on the display device, the icon image

indicating that the file is audio, and to playing back the audio upon operation to the icon image (Fig. 1, page 2, paragraph [0030]).

12. As per independent claim 4, Gohda teaches a system for processing of a representative picture of a moving image file (page 1, paragraph [0002]). Gohda does not explicitly teach selecting a file. However, Pruett teaches the claimed, when an audio file stored in a first folder is selected to be stored into a second folder, comparing a filename of the selected file with a filename of each file already stored in the second folder, as the computer world where files are stored in electronic file folders and either moved or copied between them (Fig. 2A, col. 6, lines 15, lines 28-30). Further, Pruett teaches the claimed, to attach a filename to the selected file and store the selected file into the second folder (Fig. 2B, col. 6, lines 42-44). Gohda teaches the claimed, displaying an icon image on a display device, the icon image indicating that the file is audio, for the selected file and an audio file stored in the second folder (Fig. 7, page 5, paragraph [0089]). Gohda teaches the claimed "to play back the audio upon operation to the icon image" (Fig. 7, page 5, paragraph [0089]).

Gohda and Pruett do not explicitly teach asking a user whether to overwrite a file. However, Nelson teaches the claimed, asking a user whether to overwrite the file (Fig. 2, col. 7, lines 46-52). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Nelson's teachings would have allowed Gohda's method to provide a user previous version if a change need to be reversed (col. 1, lines 56-58).

13. As per independent claims 5, 10, Gohda teaches a system for processing of a representative picture of a moving image file (page 1, paragraph [0002]). Gohda does not explicitly teach selecting a file. However, Pruett teaches the claimed, comparing a filename of at least one of an image file, a movie file, and an audio file which is stored in a first folder, and which is selected to be stored into a second folder, with a filename of each file already stored in the second folder, as the computer world where files are stored in electronic file folders and either moved or copied between them (Fig. 2A, col. 6, lines 15, lines 28-30). Gohda does not explicitly teach checking whether the same name exists on the second folder. However, Pruett teaches the claimed, storing the selected file into the second folder when the second folder contains no file having a filename which is same as the selected file, if the second folder contains a file having a filename same as the selected file (Fig. 2B, col. 6, lines 42-44). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Pruett's teachings would have allowed Allam's method to provide an automatic synchronization of directories in order to eliminate inefficient and time-consuming method by using standard operating system commands (col. 1, lines 56-58). Finally, Gohda teaches the claimed, displaying, when the second folder contains a file having a filename that is the same as the selected file, a thumbnail image and file information of the selected file together with a thumbnail image and file information of the file having the same filename on a display (Fig. 3, page 4, paragraph [0047]).



14. As per dependent claims 6, 11, Gohda teaches the claimed, if at least one of the selected file and the file having the same filename comprises a movie file, said method further comprising: displaying a first frame of a movie included in said movie file as the thumbnail image thereof on the display device (Fig. 2, page 3, paragraph [0053]).

15. As per dependent claims 7, 12, Gohda teaches the claimed, playing back the movie upon operation to the thumbnail image (Fig. 1, page 2, paragraph [0030]).

16. As per dependent claims 8, 13, Gohda teaches the claimed, if at least one of the selected file and the file having the same filename comprises an audio file, said method further comprising: displaying an icon image as the thumbnail image thereof on the display device, wherein the icon image indicates that the file comprises audio (Fig. 7, page 5, paragraph [0089]).

17. As per dependent claims 9, 14, Gohda teaches the claimed, playing back the audio upon operation to the icon image (Fig. 7, page 5, paragraph [0089]).

18. As per dependent claim 15, Gohda teaches the claimed, the method restructures data stored in all layers in the first folder into a format suitable for recording (page 10, paragraph [0194]).

***Response to Arguments***

19. Applicant's arguments filed on 8/13/2008 have been fully considered but they are moot in view of new grounds of rejection.

***Conclusion***

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sathyanarayan Pannala/  
Primary Examiner, Art Unit 2164

srp  
November 6, 2008